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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,919	01/27/2000	Dale Burns		9242

7590 05/17/2005
Roberts Abokhair & Mardula LLC
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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/491,919

Applicant(s)

BURNS ET AL.

Examiner

Beemnet W. Dada

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in reply to an amendment filed on February 07, 2005. Claims 1-15 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council (US Patent No. 6192114 A) in view of Hypponen et al. US Pub 2003/0191957 A1 (hereinafter Hypponen).

4. As per claim 1 and 10, the limitation of an email screening system is disclosed by Council, [column 3, lines 22-25]. The limitation of a sender and a recipient connected to a network is disclosed in column 3, lines 14-19 and Figure 1, and the limitation that the email screening server is also connected to the same network screening email of the recipient is disclosed in column 3, lines 19-24, lines 39-40. The limitation that the email-screening server that the email will be forwarded to the recipient for free is disclosed in column 1, lines 30-33, Figure 2. Council is silent on computer instructions for screening of email for virus. Hypponen teaches a recipient system (mail server and user work stations, see figure 1, units 4b & 2a-d)

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comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. Both Council and Hypponen teach a means for screening email messages for viruses. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the teachings of Hypponen within the system of Council, in order to further allow centralized email screening by forwarding received email to a screening system and further enhance the security of the system.

5. Claims 2-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council US Patent No. 6192114 A in view of Hypponen US Pub 2003/0191957 A1, and further in view of Hardy et. al (hereinafter Hardy) (US Patent No. 6073242 A).

6. As per claims 2 and 11, Council-Hypponen is silent with regards to the limitation that a password is used as a means of discerning authorized mail to the user. Council teaches the use of an authorization list. Hardy teaches the use of passwords as a means of authorization (Column 9, 15-17). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Hardy within the combination of Council and Hypponen. One of ordinary skill in the art at the time the invention was made would have been motivated to use a password system as opposed to an authorization list because such list are difficult to keep updated.

7. As per claim 3, the screener holding email without a password. It is inherent in the Council-Hypponen system, since if the sending part is not authorized to send electronic mail to the recipient then the sending party is asked to provide a fee for delivery to the recipient

(Column 1, lines 28-33). Thus in the Council-Hyponen-Hardy system the email would have to be held to determine if the sender is willing to pay the fee.

8. As per claim 4, alerting the recipient that an email message is being held by the screening computer which is without password authorization is disclosed by Council. Council any or all of the fee may be paid by the receiving party, which implies that the receiving party must be alerted to authorized mail in order to be given a chance to pay the fee. Claim 4 is rejected.

9. As per claim 5, the limitation that the email screening system further charges the sender a fee to forward email message that is not password authorized to the recipient is disclosed by Council [Column 1, lines 30-33]. Claim 5 is rejected.

10. As per claim 6, the limitation of a method for screening email, which screens the email for viruses and forwards to recipient if password authorized but holds email if not password authorized is disclosed by the Council/Hyponen/Hardy combination. In particular Council describes the email scanner with authorization list [Column 1, lines 29-33 and Column 3, lines 15-40], Hardy modifies this to allow password authorization [Column 9, lines 15-18] and Hyponen teaches a recipient system (mail server and user work stations, see figure 1, unit 4b & 2a-d) comprising software instruction for forwarding email messages to email screening server (virus scanning server see figure 1, unit 7) [see page 2, 0035-0036 & 0040-0041]. Motivation to combine Council and Hardy is that authorization list are too difficult to keep updated, motivation to modify by Hyponen is in order to further allow centralized email

screening by forwarding received email to a screening system and further enhance security of the system.

11. As per claim 7, the limitation of notifying the sender and recipient was addressed in claim 4 and charging the sender fees [see Figure 2 of Council].

12. As per claim 8, the limitation of providing the recipient the option of receiving email without authorization is not disclosed by the Council/Hardy/hypponen but such a option would certainly be one that would be obvious to one of ordinary skill in the art at the time of the invention because if the recipient is out of town for an extended time, they might not wish to miss unexpected mail.

13. As per claim 9, the limitation of sharing the fee with the recipient is disclosed by Council [Column 3, lines 54-56].

14. As per claim 12, the method of automatically forwarding password authorized email to recipient (Council Figure 2, Hardy Column9, lines 15-17). Claim 12 is rejected.

15. As per claim 13, the limitation of notifying sender that email is not password authorized and charging a fee to sender for delivery is disclosed in Council Figure 2, and Hardy (Column 9, lines 15-17). Claim 13 is rejected.

16. As per claim 14, the limitation of sharing fee with recipient (that is a percentage to the recipient) Column 4, 28-30. Claim 14 is rejected.

17. As per claim 15, the limitation of providing a recipient with option to pay for screening and sending email is disclosed by Council column 3, lines 54-55. Claim 15 is rejected.

Response to Arguments

18. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 14, 2005